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DEC 23 2008

OFFICE OF PETITIONS

In re Application of :  
SALDANA et al. :  
Application No. 09/748,708 : DECISION ON APPLICATION  
Filed: December 22, 2000 : FOR  
Atty Docket No. LAM2P222A : PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)," filed November 13, 2007. Applicants request correction of the patent term adjustment from zero (0) days to 1,727 days partly on the basis of the Office taking in excess of three years to issue the patent.

The request for reconsideration of the patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct patent term adjustment determination at the time of the mailing of the notice of allowance is **zero (0) days**.<sup>1</sup> A copy of the updated PAIR screen, showing the correct determination, is enclosed.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to

<sup>1</sup> The patent term adjustment determination remains zero days; however, the number of days of reduction for applicant delay has been corrected from 1,789 days to 127 days.

calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b). It is noted that at the time of this decision the patent has not issued.

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

On October 1, 2007, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is zero (0) days. On November 13, 2007, applicants timely filed the instant request for reconsideration of the patent term adjustment.<sup>2</sup>

A review of the application file confirms that the initial patent term adjustment determination is incorrect.

Applicants state that the period of adjustment under 37 CFR 1.702(a)(1) should be 117 days, instead of 118 days. A review of the record indicates that the Office correctly calculated the period of adjustment under 37 CFR 1.702(a)(1) as 118 days, counting the number of days beginning on the day after the date that is fourteen months after the date on which the application was filed, February 23, 2002, and ending on the date of the mailing of the nonfinal Office action, June 20, 2002. "When a period is indicated (in 37 CFR 1.703 or 1.704) as 'beginning' on a particular day, that day is included in the period, in that such day is 'day one' of the period and not 'day zero.'" MPEP 2731. "For example, a period beginning on April 1 and ending on April 10 is ten (and not nine) days in length." Id.

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<sup>2</sup> Office records indicate that the issue fee payment was received on November 13, 2007.

Applicants dispute the reduction of 147 days for applicant delay in responding to the nonfinal Office action mailed June 20, 2002. Applicants assert the no reduction under 37 CFR 1.704(b) is warranted because they filed a response on September 13, 2002.

A review of the application file confirms that a reply to the nonfinal Office action was filed on September 13, 2002. On April 9, 2007, applicants submitted a copy of the response accompanied by a copy of their itemized return postcard, associated with the filing of the response, with a USPTO date-stamp of September 13, 2002. The date-stamped and itemized postcard receipt serves as prima facie evidence that the original reply was received by the Office on September 13, 2002. See MPEP 503. Under these circumstances, the date of receipt of the response on September 13, 2002, should be properly used for purposes of calculating compliance with 37 CFR 1.704(b). The response was filed within the three-month period under 37 CFR 1.704(b). Accordingly, applicants did not fail to engage in reasonable efforts to conclude processing by delaying in responding to the nonfinal Office action. The period of reduction of 147 days is not warranted and is being removed.

Applicants also dispute the reduction of 1,642 days pursuant to 37 CFR 1.704(c)(7). 37 CFR § 1.704(c)(7) states:

Submission of a reply having an omission (§ 1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed[.]

On April 9, 2007, applicants submitted a non-compliant amendment. In response, the Office mailed a Notice of Non-Compliant Amendment (37 CFR § 1.121) on July 11, 2007. On August 14, 2007, applicants filed an amendment correcting the omission.

The submission of a non-compliant amendment is a proper basis for reduction of patent term under 37 CFR § 1.704(c)(7). Accordingly, the period of adjustment of the term of the patent should be reduced by 127 days (not 1,642 days), the number of days beginning on the day after the date the non-compliant amendment was submitted, April 10, 2007, and ending on the date that the amendment correcting the omission was filed, August 14,

2007. The filing of a reply that is complete and the filing of any supplement necessary to reply having an omission are within the control of the applicant. See Comment 34 and Response in *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Thus, the period of reduction of 1,642 days will be removed and a period of reduction of 127 days will be entered.

Lastly, applicants argue that a period of adjustment of 342 days should be entered for the Office's failure to respond to a reply within four months after the date on which the reply was filed pursuant to 37 CFR 1.702(a)(2). The Office has considered applicants' argument but does not find it persuasive.

Pursuant to 37 CFR 1.702(a)(2), the period of adjustment under § 1.702(a) is the sum of the following period:

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

In this instance, applicants did not submit a complete reply under 37 CFR 1.111 until August 14, 2007. Thereafter, the Office responded with the mailing of the notice of allowance on October 1, 2007, within four months after the date the reply under 37 CFR 1.111 was filed. See 37 CFR 1.703(a)(2). Thus, the Office will not be assessed any period of delay under 37 CFR 1.702(a)(2).

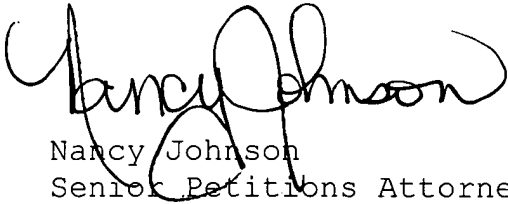
In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is zero (0) days (118 days of Office delay - 127 days of applicant delay).

The Office acknowledge the payment of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fee is required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is stylized with large, flowing loops.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Monday  
Date: 12/22/2008

# **PALM INTRANET**

Time: 14:31:37

## **PTA Calculations for Application: 09/748708**

Application Filing Date:	12/22/2000	PTO Delay (PTO):	118
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	1789
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	1662		

## **File Contents History**

Number	Date	Contents Description	PTO	APPL	START
67	12/22/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	147		
66	12/22/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		127	
65	12/22/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	1642		
51	10/01/2007	MAIL NOTICE OF ALLOWANCE			
50	09/18/2007	ISSUE REVISION COMPLETED			
49	09/18/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
48	09/18/2007	CASE DOCKETED TO EXAMINER IN GAU			
47	09/18/2007	DOCUMENT VERIFICATION			
46	09/17/2007	NOTICE OF ALLOWABILITY			
45	03/20/2001	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
44	08/16/2002	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
43	08/14/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
40	08/14/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
39	08/14/2007	NEW OR ADDITIONAL DRAWING FILED			
38	08/22/2007	DATE FORWARDED TO EXAMINER			
37	08/14/2007	RESPONSE AFTER NON-FINAL ACTION		1642	24
36	08/14/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
35	08/14/2007	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
34	02/14/2003	NEW OR ADDITIONAL DRAWING FILED			
33	08/16/2002	REFERENCE CAPTURE ON IDS			

32	08/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
31	03/20/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30	07/11/2007	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
29	07/09/2007	CASE DOCKETED TO EXAMINER IN GAU			
28	05/17/2007	CASE DOCKETED TO EXAMINER IN GAU			
27	08/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	03/20/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	05/04/2007	DATE FORWARDED TO EXAMINER			
24.1	02/14/2003	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
24	02/14/2003	RESPONSE AFTER NON-FINAL ACTION		147	14
23	05/07/2007	MAIL NOTICE OF RESCINDED ABANDONMENT			
22	05/04/2007	NOTICE OF RESCINDED ABANDONMENT IN TCS			
21	05/04/2007	CASE DOCKETED TO EXAMINER IN GAU			
20	05/07/2007	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
19	04/09/2007	PETITION ENTERED			
17	01/29/2003	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
16	01/27/2003	ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
14	06/20/2002	MAIL NON-FINAL REJECTION	118		-1
13	06/18/2002	NON-FINAL REJECTION			
12	05/01/2002	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
11	01/08/2002	PETITION ENTERED			
9	05/07/2001	PRELIMINARY AMENDMENT			
8	07/23/2001	CASE DOCKETED TO EXAMINER IN GAU			
7	07/02/2001	APPLICATION DISPATCHED FROM OIPE			
6	02/20/2001	APPLICATION IS NOW COMPLETE			
5	02/20/2001	APPLICATION IS NOW COMPLETE			
4	02/16/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	02/15/2001	CORRESPONDENCE ADDRESS CHANGE			

2	01/22/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	12/22/2000	INITIAL EXAM TEAM NN			

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### **EXPLANATION OF PTA CALCULATION**

### **EXPLANATION OF PTE CALCULATION**

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